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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,717	07/13/2001	Anders Onshage	032927-012	9292

7590 03/28/2003

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EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 03/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,717

Applicant(s)

ONSHAGE ET AL.

Examiner

Ming Chow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (US: 6529602).

Regarding claims 1, 4, 5, 8 and 14, Walker et al teach a method and apparatus for recording telephone conversations users. Walker et al also teach on column 6 line 44-67 the first party (claimed “first telecommunication device” which includes item 13 and item 12 of Fig. 1A) sends a message requesting authorization to the second telecommunication device for the recording. The second telecommunication device responds authorization to the first telecommunication device by using the touch tone keys or with a voice command.

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For claim 4, regarding the recording being performed under control of said first telecommunication device, Walker et al teach on column 7 line 1-2 the audio vault (the claimed “first telecommunication device” controls the recording).

Regarding claim 2, it is inherent that when the authorization responded by the second telecommunication device is negative the recording is prohibited.

Regarding claim 3, Walker et al teach on column 6 line 63-65 the requesting message is a voice message.

Regarding claims 6, 10 and 15, the system of Walker et al must advise the user of the first telecommunication device whether the authorization request is granted or not.

Regarding claim 7, regarding “said telephone conversation.....additional telecommunication device”. Walker et al teach on column 5 line 23-25 embodiment for recording conference call.

Regarding claim 9, Walker et al teach on column 6 line 54-57, voice recognition processor.

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Regarding claims 11 and 16, Walker et al teach on column 6 line 44-67 the authorization from the second party is received (reads on the claimed “stored”) by the audio vault (the claimed “device”).

Regarding claim 12, Walker et al teach on column 12 line 50-54 the system could use triangulating cellular phone signals. It is obvious that the telephone devices taught by Walker et al include cellular telephones (the claimed “mobile telephone”).

Regarding 13, Walker et al teach on column 6 line 57-67, the audio vault (the claimed “telecommunication device”) automatically responds to the authorization request by sending a query to the second party.

Response to Arguments

2. Applicant's arguments filed on 1/28/03 have been fully considered but they are not persuasive.

- i) Applicant argues, on page 6, regarding foreign priority and domestic priority acknowledgement. The acknowledgements are indicated in the office action summary attached to this office action.

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- ii) All other arguments stated on page 7-13 are not applicable due to new prior arts are referenced relative to new grounds necessitated by the amendments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***** NOTICE *****

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ANY AMENDMENT OR REQUEST FOR RECONSIDERATION IN RESPONSE TO THIS
FINAL OFFICE ACTION SHOULD BE DIRECTED TO:

Commissioner of Patents and Trademarks

Box AF

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By addressing all after final office action responses to the above address, processing time of the response is included. This will result in more timely responses by the Office and should result in fewer requests for extension of time.

3. Any inquiry concerning this communication or earlier communication from the examiner should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any inquiry of a general nature or relating to the status of this application or proceeding should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

Art Unit 2645

Ming Chow

(w)

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

